

REMARKS

The present application was filed on February 1, 2001 with claims 1-19. In the outstanding Office Action dated May 14, 2004, the Examiner has: (i) rejected claims 1-5, 7-14 and 16-19 under 35 U.S.C. §102(e) as being unpatentable over U.S. Patent No. 6,363,258 to Schmidt et al. (hereinafter "Schmidt"); and (ii) rejected claims 6 and 15 under §103(a) as being unpatentable over Schmidt, in view of U.S. Patent No. 6,260,012 to Park (hereinafter "Park").

In this response, Applicant traverses the §102(e) and §103(a) rejections and respectfully requests reconsideration of the present application in view of the following remarks.

Claims 1-5, 7-14 and 16-19 stand rejected under §102(e) as being anticipated by Schmidt. With regard to independent claims 1, 10 and 18, which are of similar scope, the Examiner contends that Schmidt discloses all of the elements set forth in the subject claims. Applicant respectfully disagrees with the Examiner's contention. Schmidt is directed to a method of supplying certain types of communications terminals with an indication of call type for group calls so as to distinguish such group calls from other types of incoming calls, thereby allowing the user of the communications terminal to respond appropriately (Schmidt; column 2, lines 30-33). The methodology and system taught by Schmidt is not reasonably analogous to the claimed invention.

Claims 1, 10 and 18 are clearly distinguishable from the prior art of record. Specifically, Schmidt fails to disclose a portable communication device uniquely configured to facilitate group communications relating to predefined discussion topics. Schmidt discloses, in essence, a mobile cellular phone which is capable of indicating that a particular incoming call is a group call. Schmidt defines a group call as a special type of call "where the call originator is trying to communicate with one or more members of a predefined user group" (Schmidt; column 1, lines 49-50). Schmidt further discloses that "while less than all the group members may be participating in any given group call, the list of possible participants in the group call . . . is known before the call begins" (Schmidt; column 1, lines 61-65; emphasis added). While the list of participants in a given group call disclosed by Schmidt is predefined, the discussion topic is not, as is required by the claimed invention.

Schmidt also fails to disclose a transceiver capable of sending and receiving signals on one of a plurality of channels, each channel corresponding to a predefined discussion topic, as recited

in the subject claims. In contrast to the claimed invention, Schmidt discloses a methodology for indicating the call type of an incoming call received by the phone. Schmidt fails to disclose a channel selector that enables a user to select one of the plurality of channels based on predefined discussion topics corresponding to the channels, as required by the claimed invention.

For at least the reasons given above, Applicant submits that claims 1, 10 and 18 are patentable over the prior art of record. Accordingly, favorable reconsideration and allowance of claims 1, 10 and 18 are respectfully solicited.

With regard to claims 2-5 and 7-9, which depend from claim 1, claims 11-14, 16 and 17, which depend from claim 10, and claim 19, which depends from claim 18, Applicant submits that these claims are also patentable over the prior art at least by virtue of their dependency from their respective base claims. Moreover, one or more of these claims define additional patentable subject matter in their own right. For example, claim 2 further defines the transceiver as including "at least one user-definable channel, the user-definable channel being assigned to a particular discussion topic by the user." The Examiner contends that Schmidt teaches this feature at column 1, lines 45-50. Applicant respectfully disagrees with this contention.

Schmidt, at column 1, lines 45-50, states:

With increasing frequency, cellular telephones, other mobile terminals, and communications terminals in general are being used for group calls. Group calls are special types of calls where the call originator is trying to communicate with one or more members of a predefined user group.

However, nowhere does Schmidt disclose that the transceiver includes at least one user-definable channel, or that the user-definable channel corresponds to a user-assignable discussion topic, as required by claim 2.

Likewise, claim 4 further defines the portable communication device as including a display for visually indicating at least one of a selected channel, a corresponding discussion topic assigned to the selected channel, and a number of users participating in the selected discussion topic. The Examiner contends that Schmidt discloses such features at column 3, lines 54-63. Applicant respectfully disagrees with this contention. While Schmidt may disclose a cellular telephone including a display in the general sense, Applicant asserts that a display, by itself, does not

inherently show various aspects and information related to each call, as the Examiner alleges (Office Action; page 3, paragraph 7). Moreover, while Schmidt states that the display “allows the operator to see dialed digits, call status, and other service information” (Schmidt; column 3, lines 59-60), Schmidt fails to disclose that the display indicates a selected channel, a corresponding discussion topic assigned to the selected channel, and/or the number of users participating in the selected discussion topic, as required by claim 4. And such information, which is not analogous to service information as taught by Schmidt, is not inherently displayed in a standard mobile communication device.

According to the Federal Circuit, “[i]nherency does not embrace probabilities or possibilities.” Trintec Industries, Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1297, 63 USPQ2d 1597 (Fed. Cir. 2002). Further, an inherent anticipation requires that the missing descriptive material is necessarily present, and not merely probably or possibly present, in the prior art. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). There is an absence in Schmidt of any teaching of displaying a selected channel, displaying a corresponding discussion topic assigned to the selected channel, and/or displaying the number of users participating in the selected discussion topic. Furthermore, such information is not displayed in conventional mobile communication devices. Therefore, there is no reasonable basis for an assertion that a portable communication device configured as set forth in claim 4 of the present application, necessarily flows from the mobile phone disclosed in the Schmidt reference, and thus is inherent. No such basis and/or technical reasoning has been provided by the Examiner in the present Office Action.

Claim 9 further defines the portable communicator device as including “an on-line indicator being responsive to at least one of: (i) a participant entering a selected channel and (ii) a participant leaving the selected channel, the on-line indicator providing an indication in response thereto.” The Examiner contends that Schmidt discloses such features at column 2, lines 50-60. Applicant respectfully disagrees with this contention and submits that nowhere does Schmidt disclose providing an indication to the user as to when a participant in the selected channel (e.g., discussion group) enters or leaves the channel, as required by claim 9. Rather, Schmidt merely discloses that a group call server may initiate a paging message to a mobile phone user including certain information relating to the incoming group call, such as a priority level of the call (Schmidt; column

Application Serial No. 09/773,955

2, lines 50-59). Schmidt further teaches that the user may base his response as to whether or not to answer the incoming call on the characteristics of the call indicated in the paging message (Schmidt; column 2, lines 59-63). This is clearly distinguishable from the invention set forth in claim 9.

For at least the above reasons, claims 2-5, 7-9, 11-14, 16, 17 and 19 are believed to be patentable over the prior art, not merely by virtue of their dependency from their respective base claims, but also in their own right. Accordingly, favorable reconsideration and allowance of claims 2-5, 7-9, 11-14, 16, 17 and 19 are respectfully requested.

Claims 6 and 15 stand rejected under §103(a) as being unpatentable over Schmidt in view of Park. While disagreeing with the Examiner's contention that Park supplements the deficiencies of Schmidt, Applicant asserts that claim 6, which depends from claim 1, and claim 15, which depends from claim 10, are also patentable over the prior art at least by virtue of their dependency from their respective base claims. Moreover, these claims define additional patentable subject matter in their own right. Accordingly, favorable reconsideration and allowance of claims 6 and 15 are respectfully solicited.

In view of the foregoing, Applicant believes that claims 1-19, which are currently pending in the present application, are in condition for allowance, and respectfully requests withdrawal of the §102 and §103 rejections.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Wayne L. Ellenbogen", with a long, sweeping horizontal line extending to the right.

Date: August 16, 2004

Wayne L. Ellenbogen
Attorney for Applicant(s)
Reg. No. 43,602
Ryan, Mason & Lewis, LLP
90 Forest Avenue
Locust Valley, NY 11560
(516) 759-7662